

REMARKS

The non-final Office Action mailed March 19, 2008, Notice of Non-Compliance mailed October 17, 2008, and references cited therein have been received and reviewed. Applicant has, by this Amendment, canceled claims 3 and 4, and amended claims 1, 2, 15, 16, 53, 78 and 80.

NEW MATTER REJECTION

The Examiner stated that the Amendment filed on June 17, 2008 was not fully responsive since claims 2, 78 and 80 included new matter. Applicant respectfully submits that the limitations objected to by the Examiner are supported by the originally filed Specification, drawings and claims, thus such objections should be withdrawn.

The Examiner asserted that the limitation "a majority of said substantially spherical or ellipsoidal body is non-expandable" in claim 2 is not supported by the originally filed Specification, drawings and claims. Applicant submits that original Figures 13-18 support such limitation in claim 2. Figures 13-18 disclose that the stabilizer is expandable by one or more mechanisms and/or arrangements. (P. 27, ln. 23 to P. 35, ln. 2). The prosthetic plant 120 in Figure 13 is disclosed as including a spherical body 130 formed of two semi-hemispherical sections 132, 134 and an expandable stabilizer 140. (P. 29, lns. 23-26). The two semi-hemispherical sections 132, 134 are made of a durable material that resists deformation that is set in shape, as opposed to the stabilizer which is expandable. (P. 29, ln. 28 to P. 30, ln. 2). As clearly illustrated in Figure 13, one skilled in the art would readily understand and acknowledge that the two semi-hemispherical sections 132, 134 form a significant majority of the volume of the prosthetic plant 120 and the stabilizer, even in an expanded state, constitutes a significant minority of the volume of the prosthetic plant 120.

Similar teachings are conveyed to one skilled in the art when viewing Figures 14-18 in combination with the original Specification. (P. 31, Ins. 20-30; P. 32, ln. 23 to P. 33, ln. 2; P. 33, ln. 25 to P. 34, ln. 3). Figure 18 best illustrates the relative sizes of the two semi-hemispherical sections 132, 134 and an expandable stabilizer 140 of one non-limiting arrangement of the prosthetic plant 120. applicant acknowledges that the original Specification teaches that the size of the stabilizer can be larger and smaller than the stabilizer illustrated in the figures; however, the original figures fully support the limitation of claim 2 that "a majority of said substantially spherical or ellipsoidal body is non-expandable. Applicant requests that the objection to claim 2 be withdrawn.

The Examiner also asserted that the limitation that "at least one expandable component at least partially expands while said non-expandable component substantially retains its same form" in claims 78 and 80 is not supported by the originally filed Specification, drawings and claims. As discussed above regarding Figures 13-18, the originally filed Specification teaches one skilled in the art that two semi-hemispherical sections are made of a durable material that resists deformation that is set in shape, as opposed to the stabilizer which is expandable. (P. 29, ln. 28 to P. 30, ln. 2; P. 31, Ins. 20-30; P. 32, ln. 23 to P. 33, ln. 2; P. 33, ln. 25 to P. 34, ln. 3). Applicant requests that the objection to claims 78 and 80 be withdrawn.

OATH

The Examiner objected to the oath as not including a statement under Section 1.56. Applicant disagrees. The originally filed oath and declaration states that the inventor "acknowledge the duty to disclose information which is material to patentability and/or examination of this application in accordance with Title 37, Code of Federal Regulations §1.56(a)." Section 1.56(a) sets

forth the obligation to an inventor whereas the other portions of the Section 1.56 define several terms in Section 1.56(a). Applicant submits that the originally filed oath is not defective.

DOUBLE PATENTING

Claims 1-4, 7, 21 and 26 were rejected on the ground of non-statutory obviousness-type double patenting over several claims of US 6,478,822. Pending claim 1 requires that the prosthetic implant include at least one expandable component. None of the components of the implant disclosed in the '822 patent are expandable. As such, the prosthetic implant defined in the pending claims are patentably distinct from the prosthetic implant defined in the claims of the '822 patent. Applicant requests that the rejection based on non-statutory obviousness-type double patenting over US 6,478,822 be withdrawn.

THE SECTION 102 AND 103 REJECTIONS

Claims 1-8, 12, 15-22, 24-33, 35-37, 39, 53, 78 and 80 were rejected under 35 U.S.C. §102(b) as being anticipated by Kuslich. Claims 14 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kuslich.

Kuslich discloses an implant 40 that consists of an expandable bag and an equatorial band 42 that limits the expansion of the bag. (Col 6, ln. 57 to Col. 7, ln. 53). The bag is expanded by inserting material into the interior of the bag. (Col. 9, lns. 13-24).

Independent claims 1, 53, 78 and 80 have been amended to require that at least a portion of the spherical or ellipsoidal body of the implant includes a non-expandable component and at least one expandable component. Kuslich discloses an implant that consists of an expandable bag. All

of the components of the implant disclosed in Kuslich are expandable. As such, the teachings of Kuslich do not anticipate or make obvious any of the pending claims.

It is also arguable that band 42 disclosed in Kuslich is not an expandable component. The band 42 is designed to limit the expansion of bag 40. If such interpretation of Kuslich is adopted, none of the pending claims are anticipated or made obvious by Kuslich. Claim 1 requires an expandable stabilizer. Kuslich does not disclose an expandable stabilizer. Claim 53 requires that the expandable region in an expanded state have a larger perimeter than the non-expandable region. Band 42 of Kuslich never has a smaller perimeter than the body in an expanded or non-expanded state. Claims 78 and 80 require the non-expandable component to substantially retain its shape and form during the expansion of the at least one expandable component. Band 42 is a flexible component that changes its shape and/or form during the expansion of the bag.

Applicant submits that for at least the reasons set forth above, none of the pending claims are anticipated or made obvious by the teachings of Kuslich. A notice of allowance of the claims is earnestly solicited.

Respectfully submitted,
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